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EXAMINER

BOYD, JENNIFER A

ART UNIT PAPER NUMBER

1771

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

10/743,859

Applicant(s)

OMMERBORN, DAGMAR

Examiner

Jennifer A. Boyd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 26, 2006 has been entered. The Applicant's Amendments and Accompanying Remarks, filed June 26, 2006, have been entered and have been carefully considered. Claim 1 is amended and claims 1 – 25 are pending. In view of Applicant's arguments that Evans does not teach the warp knitted fabric as claimed by Applicant, the Examiner withdraws all previously set forth rejections. The invention as currently claimed is not found to be patentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1 – 3, 5 – 6, 8 – 14 and 16 – 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rochford et al. (GB 1,406,990).

Rochford et al. is directed to a surgical plaster (Title).

As to claims 1, 14 and 18, Rochford et al. teach a surgical plaster comprising pressure

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sensitive adhesive coated on a warp-knitted fabric backing material (page 1, lines 45 – 60).

Rochford et al. teach the use of semi-satin weave (page 2, lines 1 – 20). Rochford et al. teach in the Example the use of a two yarn system. It should be noted that the recitation of “a self-windable adhesive tape...” is not given patentable weight at this time since the prior art meets the structural and/or chemical limitations set forth and there is nothing on record to evidence that the prior art product could not function in the desired capacity. The burden is shifted upon the Applicant to evidence the contrary. It should be noted that the limitation of “adapted to cable winding” is considered to be an “adapted to” type limitation. It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Furthermore, it should be noted that method of making the article is not germane to the issue of patentability of the final product itself. In this instance, the limitation of “providing the carrier with a smooth surface, visually indicated by an optical lustrous appearance, on which the pressure-sensitive coating is applied” is given no patentable weight because the optical lustrous appearance and the substantially smooth surface would not be present in the final product because the pressure-sensitive coating would be covering the surface. Although Rochford does teach the use of a semi-satin knit, the limitation has not been given patentable weight.

As to claim 2, Rochford et al. teach that the fabric is a warp knit as discussed above.

As to claims 12 and 23, Rochford et al. teach that the warp knitted fabric can comprise yarns such as nylon (polyamide), polyester, polyacrylate, polyvinyl alcohol or polyurethane (page 1, lines 85 – 90).

As to claim 13, Rochford et al. teach in the Example the use of a two yarn system.

As to claims 16 and 24 - 25, Rochford et al. teach that the yarn has a linear density of 10 – 100 denier (11.1 – 111 dtex) (page 1, lines 85 – 90).

As to claims 1, 3, 8 – 11 and 21 – 22, Rochford et al. disclose the claimed invention except for the material thickness is 0.1 – 1.0 mm, the basis weight is between 40 – 200 gsm and the adhesive coating weighs 20 – 150 gsm as required by claims 1 and 18, the basis weight is 70 – 110 gsm as required by claim 3, adhesive coating weighs no more than 65 gsm as required by claim 8, the carrier thickness is 0.2 to 0.7 mm as required by claim 9, the stitch density is at least 80 per dm as required by claim 10 and between 195 per dm to 250 per dm as required by claim 21 and the wale density is at least 80 per dm as required by claim 11 and between 110 to 150 per dm as required by claim 22. Absent unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to create a tape having the claimed specifications in regards to thickness, adhesive weight, basis weight, stitch and wale density, since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454 USPQ 233 (CCPA 1955). In the present invention, one would have been motivated to optimize the material thickness, basis weight, adhesive weight and stitch and wale density in order to create a self-adhering splint with optimal flexibility and strength.

As to claims 5 – 6, 17 and 19 – 20, although Rochford et al. do not explicitly teach the claimed breaking strength of at least 15 N/cm as required by claim 5 and between 15 – 70 N/cm

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as required by claim 19, the breaking extension not more than 60% as required by claim 6 and between 10 – 25% as required by claim 20 and bond strength on steel of more than 3 N/cm as required by claim 17, it is reasonable to presume said properties are inherent. Support for said presumption is found in the use of like materials (i.e. a warp knitted fabric having a pressure sensitive adhesive coating comprising the same yarns with a similar range of linear density) which would result in the claimed properties. The burden is upon the Applicant to prove otherwise. In addition, the presently claimed properties would obviously have been present once the Rochford et al. product is provided.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rochford et al. (GB 1,406,990) in view of Murphy et al. (US 5,762,623).

Rochford et al. teach the claimed invention above but fails to teach that the adhesive tape is hand tearable in the cross direction.

Murphy is directed to an elastic bandage (Title) comprising a warp-knitted weft insertion fabric (Abstract). Murphy teaches that the tape is hand tearable (column 3, lines 20 - 35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the tape of Rochford tearable as suggested by Murphy motivated by the desire to easily create a tape with the desired length depending on end use.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rochford et al. (GB 1,406,990) in view of the article entitled "Solvent-Free Radiation-Curable Polyacrylate Pressure-Sensitive Adhesive Systems" by Z. Czech, et al.

Rochford et al. teach that the adhesive coating can comprise conventional rubber-resin adhesives, polyvinyl ether adhesives or acrylate adhesives (page 2, lines 65 – 75).

Rochford et al. fail to teach that the adhesive is UV crosslinked as required by claim 7.

The article teaches that there is a broad spectrum for UV-crosslinkable polyacrylate hot-melt pressure sensitive adhesives including medical or hygiene products such as bandaids because of their excellent adhesion and good skin compatibility (page 190, column 2).

It would have been obvious to one of ordinary skill in the art to UV crosslink the adhesive of Rochford et al. as suggested by the article motivated by the desire to improve the adhesion strength of the adhesive layer.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rochford et al. (GB 1,406,990) in view of Spillane et al. (US 4,881,383).

Rochford et al. teach the claimed invention above but fails to teach that the

Rochford et al. fail to teach that the knit includes fixed stitches with a lapping structure having a combination of threads in a velvet construction and threads in a pillar stitched construction to provide a tearable knit.

Spillane teaches a warp knitted fabric having a satin-effect by warp knitting a set of yarns in a stitch pattern extending underlaps of the yarn at the technical back of the fabric. The underlaps will provide a surface appearance of a satin weave. Spillane teaches that the another set of warp yarns may be knitted in a jersey, chain or other plain stitch pattern at the technical face of the fabric as a substrate or ground to provide structural integrity to the fabric (column 1).

See Figure 1 for satin stitch (II) and chain stitch or pillar stitch (III) configurations. Spillane notes that the fabric has a glossy satin face (column 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the satin stitch with the chain stitch of Evans as suggested by Spillane to create a bandage with structural integrity.

Response to Arguments

7. Applicant's arguments with respect to claims 1 – 25 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's argument regarding that Spillane teaches a three-bar combination while Applicant only claims a two-yarn system, the Examiner submits that the requirement of claim 13 is open-ended and could include additional yarns. Furthermore, the newly applied reference, Rochford et al., teach that two or more warps may be used and a wide range of knitting patterns may be used. Please see the revised rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jennifer Boyd
September 11, 2006


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